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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,342	05/29/2001	I-Wen Winnie Tsou	6487-54286 (25916-193)	7717
30764 7590 01/25/2007 SHEPPARD, MULLIN, RICHTER & HAMPTON LLP 333 SOUTH HOPE STREET 48TH FLOOR LOS ANGELES, CA 90071-1448			EXAMINER BEKERMANN, MICHAEL	
			ART UNIT	PAPER NUMBER
			3622	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/25/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/870,342

Applicant(s)

TSOU ET AL.

Examiner

Michael Bekerman

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/21/2006 has been entered.

Claim Objections

2. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 6 recites business information as being location information. This is already recited in claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 3622

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 4-6, 8-25, 27-29, and 32-36 are rejected under 35 U.S.C. 102(e)

as being anticipated by Mitsuoka (U.S. Pub No. 2002/0026355). Mitsuoka teaches a system and method for real-time instant presence with advertisement that includes all of the limitations recited in the above claims.

Regarding claims 1, 2, 4, and 6, Mitsuoka teaches storing business information identifying said business, retrieving said business information, and transmitting the business information as presence information to a wireless device of an instant messaging user (Paragraphs 0016-0017). The presence information is stored in the wireless device without requiring manual entry actions (Paragraph 0063). The retrieving of said presence information is in response to a single action of clicking a button (Paragraphs 0022-0023). Mitsuoka teaches the business information as being the name of said business (Figure 10a). Since the icon is set when the user comes to a physical location (outlet), this represents location information.

Regarding claim 5, Mitsuoka teaches communication with a wireless signal when the user device is in range inside an outlet (Paragraph 0063).

Regarding claims 8-11, Mitsuoka teaches one or more instant messaging users having created an instant messaging address list containing the identity of the first instant messaging user and capable of receiving presence information from the first user (Paragraph 0126). The device in which the instant messaging client is installed is

inherent. The subscription to an instant messaging service and the instant messaging server are also both inherent.

Regarding claims 12-14, Mitsuoka teaches the displaying of a selectable icon that can be selected to show text that represents further business information (Figures 12a-12c).

Regarding claims 15-19, Mitsuoka teaches the transmitting of a user profile (containing contact information) to the user DB (the user database is apart of an awareness server of which the business system is also apart) (Paragraphs 0134 and 0135). The act of explicit enablement is satisfied through the registering process. Presence information is also sent through the instant messaging server (Paragraphs 0136 and 0137).

Regarding claim 20, the ability to display presence information on the wireless device that sets the presence information is an inherent feature.

Regarding claims 21-25 and 27, Mitsuoka teaches a storage component for storing business advertising information (the icon is considered to be an advertisement for the business) (Figure 12a and Paragraph 0062), and a business client device that comprises a wireless communication component (Paragraphs 0062 and 0063), a transmitting component (Paragraphs 0062 and 0063), a receiving component for receiving a user profile (Paragraph 0134), and a user database component (Paragraph 0135). The user profile is sent after the user registers (or agrees). Mitsuoka also teaches a statistics component to receive and store statistics reports on user activity, the statistics reports (the database display is a report) comprising information for

business analysis and measurement of marketing success (Paragraph 0202 and Figure 4). Since the icon is set when the user comes to a physical location (outlet), this represents location information.

Regarding claims 28 and 29, Mitsuoka teaches the sending of presence information to a first instant messaging user and to other instant messaging users that have the first instant messaging user on an address list (Paragraphs 0016-0018 and 0026-0027). Mitsuoka also teaches the displaying of said presence information, the presence information including a link to advertisements for a business and including a short text message (Figures 12a-12c). The user visits the webpage of the business, which constitutes visiting the business online. Since the icon is set when the user comes to a physical location (outlet), this represents location information.

Regarding claims 32-36, Mitsuoka teaches a first instant messaging user wireless device (Paragraphs 0016 and 0017), a device at a business for receiving real time presence information and for sending business information (Paragraphs 0062 and 0063), and one or more additional instant messaging devices that have address lists containing the identity of the first user (Paragraph 0127) and receive presence information from the first instant messaging user (Paragraph 0018). An instant messaging server is inherent in the system, and it is inherent that when presence information is sent between two users, it will go through the server first. The awareness server has a user database and an http server to communicate via the Internet (Paragraph 0134). The business device includes a statistics component whereby statistics are sent from a database to the business database (Paragraph 0202). Since

the icon is set when the user comes to a physical location (outlet), this represents location information.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuoka (U.S. Pub No. 2002/0026355).

Regarding claim 26, Mitsuoka doesn't teach statistics reports as being printed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to print a hard copy of such database reports. This way, hard copy records may be kept to prevent loss by malfunction.

5. Claims 7, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuoka (U.S. Pub No. 2002/0026355) in view of Otani (U.S. Pub No. 2002/0065718).

Regarding claims 7, 30 and 31, Mitsuoka doesn't specify dynamic updates with additional promotions that link instant message users to a webpage. Otani teaches a user presence that shows a dated advertisement with a link to the homepage (Figures 12a and 12b). Due to the advertisement being dated, dynamic updating of the

advertisement must be inherent. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include dated advertisements and links to the business homepage in the system of Mitsuoka. This would allow for greater advertising flexibility and depth.

Response to Arguments

6. **Regarding the 102(e) rejection for claim 1**, applicant argues that Mitsuoka's method for adding advertiser status symbols to a list of owned status symbols by clicking a button is different from applicant's method of receiving presence information in response to a single action performed by an instant messaging user. Examiner understands the status symbol to read on presence information and the clicking of the button to read on a user action. Examiner recommends that applicant should reference Mitsuoka paragraph 0022 in combination with paragraph 0023 for further understanding of this rejection.

7. **Regarding the 102(e) rejection for claim 21**, applicant argues that the cited section of Mitsuoka "has nothing to do with a statistics component..." The second portion of paragraph 0202 reads "Then the incentive module determines incentive for each user according to reference count". Not only is Mitsuoka's reference count considered a statistic, but the act of determining the incentive is considered a statistical analysis. Since this information is inherently displayed, this is considered to be a report.

8. **Regarding the 102(e) rejection for claim 28**, applicant argues that Mitsuoka does not disclose sending presence information to a visiting instant messaging user

who visits a business. Examiner respectfully disagrees, as the user is indeed visiting the business at an online location through a webpage.

9. **Regarding the 102(e) rejection for claim 32**, applicant argues that Mitsuoka does not teach the limitation "each additional instant messaging user devices has an instant messaging address list containing the instant messaging identity of the first instant messaging user". Applicant cites the portion of Mitsuoka that states "users can copy icons that the users do not own from status icon display of other users in a buddy list and add them to owned icons". This portion of Mitsuoka actually *does* teach applicant's limitation. A buddy list is defined in the art as a list in which users keep their friends. As known in the art, buddy lists are not accessible by anyone other than the user. When a user accesses an icon display of a user in a buddy list, the buddy list inherently belongs to them. Thus, this reads on the claim.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MB

JEFFREY COARBS
PRIMARY EXAMINER

